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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/581,717

06/05/2006

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EXAMINER

FRONDA, CHRISTIAN L

ART UNIT

PAPER NUMBER

1652

MAIL DATE

DELIVERY MODE

05/11/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/581,717	<b>Applicant(s)</b> KOGA ET AL.	
	<b>Examiner</b> CHRISTIAN L. FRONDA	<b>Art Unit</b> 1652	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 February 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 7-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-5, 7, 9-14 and 16-27 is/are allowed.
- 6) ☒ Claim(s) 8, 15 and 28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 June 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. In view of applicants' arguments and claim amendment filed 02/17/2009, the previous restriction requirement has been withdrawn.
2. Claims 1-5 and 7-28 are pending and under consideration in this Office Action.
3. The rejection of claim 6 under 35 U.S.C. 112, first paragraph, for failing to meet the enablement requirement is moot in view of the cancellation of the claim in the claim amendment filed 02/17/2009.
4. The rejection of claims 1, 5, 17, and 18 under 35 U.S.C. 102(b) as being anticipated by Rasmussen et al. (WO 91/17243, published 11/14/1991; PTO 1449 from IDS filed 06/05/2006) has been withdrawn in view of applicants' arguments and claim amendment filed 02/17/2009.

#### ***Claim Rejections - 35 U.S.C. § 112, 2nd Paragraph***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:  

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
6. Claims 15 and 28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.  

Claim 15 is vague and indefinite since it is unclear to what claim is being referred to since claim 6 has been cancelled. Appropriate correction is requested.

Claim 28 is vague and indefinite since it is unclear how treating a cellulose-containing fabric with the recited protein would improve digestibility of animal feed. Appropriate correction is requested.

***Claim Rejections - 35 U.S.C. § 112, First Paragraph***

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claim 8 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

With regard to claim 8, applicants have not sufficiently defined the conditions under which the hybridizations are to take place. Nucleic acid hybridization assays are extremely sensitive to the conditions in which they are performed. The buffer composition, pH, temperature, length of time, salt concentrations, quality and source of template nucleic acid, are all variables which determine the reproducibility of a given hybridization experiment. Given the unpredictability of the art and the nature of hybridization experiments in general, it is not sufficient to merely cite hybridization without a clear and explicit recitation of the conditions associated with the hybridization. For example, the definition of stringency as it pertains to hybridization conditions is subject to interpretation and is different from laboratory to laboratory.

Therefore, without a clear and explicit recitation of the conditions which were actually used in isolating the claimed polynucleotide which hybridize to the recited sequence of nucleotides 64-948 of SEQ ID NO: 2, the skilled artisan would not be able to practice the claimed invention and would not be reasonably apprised of the metes and bounds of the claimed invention. Without such guidance, the experimentation left to those skilled in the art is undue. Including in the claims the exact nature of the hybridization conditions used to isolate the claimed polynucleotide would aid in overcoming this rejection.

*Conclusion*

9. Claims 1-5, 7, 9-14, and 16-27 are allowed.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christian L Fronda whose telephone number is (571)272-0929. The examiner can normally be reached Monday-Thursday and alternate Fridays between 9:00AM - 5:00PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nashaat Nashed can be reached on (571)272-0934. The fax phone number for the organization where this application or proceeding is assigned is (571)273-8300.

11. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Christian L. Fronda/

Primary Examiner

Art Unit 1652